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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,565	05/31/2006	Gianmarco Polotti	LSP-1012US	2000

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EXAMINER
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SIMMONS WILLIS, TRACEY A

ART UNIT	PAPER NUMBER
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1619

MAIL DATE	DELIVERY MODE
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01/29/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,565	<b>Applicant(s)</b> POLOTTI ET AL.	
	<b>Examiner</b> TRACEY SIMMONS WILLIS	<b>Art Unit</b> 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07062005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

### *Status of the Claims*

Applicant's election without traverse of Group I including claims 1-8 in the reply filed on December 23, 2008 is acknowledged.

Claims 1-16 are pending in the current application, of which claims 1-8 are being considered on their merits. Claims 9-16 are withdrawn from consideration at this time.

This is the first Office Action on the merits of the claims.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, please note that the language of a claim must make it clear what subject matter the claim encompasses to adequately delineate its “metes and bounds.” See, e.g., the following decisions: *In re Hammack*, 427 F.2d. 1378, 1382, 166 USPQ 204, 208 (CCPA 1970); *In re Venezia*, 530 F.2d. 956, 958, 189 USPQ 149, 151 (CCPA 1976); *In re Goffe*, 526 F.2d. 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); *In re Watson*, 517 F.2d. 465, 477, 186 USPQ 11, 20 (CCPA 1975); and *In re Knowlton*, 481 F.2d. 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). The courts have also indicated that before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover. See, e.g., the following decisions: *In re Steele*, 305 F.2d. 859, 134 USPQ 292 (CCPA 1962); *In re Moore*, 439

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F 2d. 1232, 169 USPQ 236 (CCPA 1969); and *In re Merat*, 519 F 2d. 1390, 186 USPQ 471 (CCPA 1975). In this case, the claim is so indefinite as to preclude a substantive search by the Examiner.

The following is taken from MPEP 2111.03:

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term 'comprising,' the terms 'containing' and 'mixture' are open-ended."). *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition 'comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

Examiner notes that the claim as written is directed to an inverse emulsion comprising a product, but is not limited to just the product within the emulsion. The body of the claim following the term "wherein" does not further clarify if the limitations are related to the emulsion as a whole, the product, or any additional element contained within the emulsion as a whole. Examiner is not clear if the weight ratio is relative to the inverse emulsion as a whole, or the product resultant from the admixing. It is also unclear if the anionic acrylic polymer is required to be polymerized or not, as the claim uses the phrase "obtained by". Furthermore, Examiner is not clear if the concentration of acrylic monomer is relative to the weight of the emulsion as a whole or the product within the emulsion. It is not clear whether the word "wherein" limitations at lines 2 and 13 refer to the inverse emulsion or to the product of admixing. The basis of comparison for the "concentration" at line 16 is also queried. Clarification is required.

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The term "strongly acidic" in claim 1 is a relative term which renders the claim indefinite. The term "strongly acidic" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what is considered to be strongly acidic and what is not as no point of reference is cited. Clarification is required.

Because claims 2-8 depend from indefinite claim 1 and do not clarify these points of confusion, they must also be rejected under 35 U.S.C. 112, second paragraph.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,721,313 (1998, Yeung).**

*Examiner notes that this rejection is based on the interpretation that any amount of the components of the product are present as it was not clear what the amounts cited are relative to (i.e. the overall emulsion or comprised emulsion, etc.). For art purposes claim 2 is included with claim 1.*

Yeung teach of polymer emulsions formed by inverse polymerization reactions [col 4, lines 2-3]. The polymer comprises ethylenically unsaturated carboxylates, ethylenically unsaturated nonionic monomer, ethylenically unsaturated monomer containing one or more sulfonates, in particular, 2-acrylamido-2-methyl propane sulfonic acid [col 1, lines 47-48], and

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ethylenically unsaturated monomer having surface active properties, such as stearyl methacrylate [col 3, lines 35-36], and a crosslinking agent [col 1, lines 35-44]. The resultant polymer is formed as a result of forming the water-in-oil emulsion of the reactants.

One of ordinary skill in the art would have been motivated to select stearyl methacrylate as the surface active monomer, to optimize the amount of solid content in the emulsions [col 3, lines 38-40], making the invention as a whole *prima facie* obvious at the time it was made.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRACEY SIMMONS WILLIS whose telephone number is (571)270-5861. The examiner can normally be reached on Mondays to Fridays from 8:30 am to 5:30 pm. The examiner can also be reached on alternate Fridays from 8:30 am to 12:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. S.W./

Examiner, Art Unit 1619

/Lora E Barnhart/

Primary Examiner, Art Unit 1651